



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 09/584,520 | 05/31/2000 | Claude M. Leglise | INTL-0391-US (P8805) | 1973 |

7590 02/22/2005
Timothy N Trop
Trop Pruner & Hu PC
Suite 100
8554 Katy Freeway
Houston, TX 77024

EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/584,520

Applicant(s)

LEGLISE ET AL

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-16, 36-38 and 1827 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16, 1827, 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3622

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed December 6, 2004. Applicant amended claims 1 and 11 and added claims 36-38. Claims 1-5, 8-16, 18-27 and 36-38 are pending in this case.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim includes the step of restraining the customer's ability to add software or hardware. The specification discloses, in some embodiments of the present invention, the service provider is responsible for maintaining the client system in working order and as a result, the service provider may control the user's ability to add additional hardware or software to the client system to ensure that the client system runs as intended and reduces that the possibility of unexpected software or hardware problems. Nowhere in the specification is disclosed that the control includes restraining the customer's ability to add software or hardware.

Claim 21 also recites preventing the customer from adding software or hardware to the system.

Art Unit: 3622

If applicant's interpretation of the word restrain or prevent is different than the interpretation of the word control, then it is considered new matter, since it was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In light of applicant's disclosure Examiner's interpretation of the word prevent or restraining is the same as the word control. As best understood by the Examiner and in light of applicant's specification, controlling the ability of the customer to add software or hardware means as controlling what customer can add or cannot add.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 8-16, 18-27 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netsurfer as taught by "Netsurfer makes it easy" Broadwatch Magazine ; Todd Judd Erickson January 2000, in view of "ZipLink's Virtual Internet Service Provider (ISP) Program Provides complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999 (hereinafter ZipLink).

Regarding claim 1, Netsurfer teaches providing signup CD to ISP, with everything on it, branded by an ISP; providing Internet service through graphical user interface provided by the

Art Unit: 3622

service provider (ISP) (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded interface can provide user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3). Using the SoftCast, the ISP pushes content to a user computer and makes changes to the computer and pushes software updates, ... and can also fix problems including errors and software bugs... and update thirdparty software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the tremendous investment of building and maintaining a national network and the cost of staffing a customer care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be motivated to provide private-branded Internet service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the connectivity or service and customer care function enables the customers (vendors) to concentrate on building their business and avoid the tremendous investment of building and maintaining a national network, as taught by Ziplink (see page 1). Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer states "SoftCast is a technology, written by Netsurfer using Internet standards, that allows the ISP to push content to a user's computer and make changes to that computer"(see page 78 col. 3 under SOFTCAST).

Art Unit: 3622

Netsurfer also states, "The ISP can use SoftCast to push software updates, marketing materials, news or account queries to the subscriber. It can also fix problems on the subscriber's computer including registry errors or software bugs" (see page 80 col. 1 line 1-6). Further Netsurfer state "Because it is built using industry-standard protocols, SoftCast can also update any third-party software on the user's machine, such as word processors, spreadsheets or games" (see page 80 col. 1. lines 28-40). Netsurfer does not teach providing customized advertising to the client based on preferences received from the client. Official notice is taken providing customized advertising to said client based on preferences received from the client is old and well known in the art of marketing. One would be motivated to provide customized advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content. Netsurfer teaches enabling the service provider to provide control software and hardware added to user computer (see page 78 and 80 Col. 1).

Regarding claim 2, Netsurfer teaches customizing the content provided based on the customer's identity (see page 78 col. 3 and page 80 col. 1-3)

Regarding claim 3, Netsurfer teaches controlling the initial graphical user interface displayed after booting of the system (see page 78 col. 1 and 2). Netsurfer teaches, once the customer place the CD in the computer the signup program uses wizards to guide the user through the account creation and network connection processes (see page 78).

Regarding claim 4, Netsurfer does not teach providing confidential information to service provider instead of retail store. Ziplugin teaches the Virtual ISP program offering a full suite of customer card management services including customer sign-up, activation and authentication, which indicate that all the back-end services including authentication being performed by the

Art Unit: 3622

Virtual ISP (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's sign-up program with Ziplink's Virtual ISP program. One would be motivated to provide confidential information to the Internet service provider instead of the retail vendor since the service provider is the one who is performing the authentication.

Regarding claim 5, Netsurfer teaches providing the customer with a predefined set of selection (see page 80 and fig. 2&3).

Regarding claim 8, Netsurfer teaches receiving the customer preference on customer computer coupled to the service provider over the Internet, forwarding the customer preference to the service provider, customizing the content based on the information (see page 80). 9.

Regarding claim 9, Netsurfer teaches automatically directing the customer to a server associated with retail vendor when the customer wishes to obtain a product or service offered by the retail vendor (see page 78 Col. 2&3). Netsurfer teaches any ISP can have a branded desktop with its own channels and content partners and the ISP-branded interface can provide user access to the web and a direct access to the ISP's content partners (retail vendors) (see page 78, col. 2&3 and fig. 1).

Regarding claim 10, Netsurfer teaches service provider uses desktop application to control what the user sees and when, and provides e-commerce companies space on the desktop application (see page 78). Netsurfer teaches advertising included on a home page (see fig. 1). Netsurfer does not teach the advertising is related the vendor, which the Internet service provider is providing service for. Ziplink teaches the Virtual ISP program being designed to complement an organization's marketing and customer retention efforts (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of

Art Unit: 3622

Netsurfer' desktop which includes advertisement and Ziplink's Virtual ISP program. One would be motivated to include advertising related to the vendor, in order to allow the vendor to provide targeted content to the subscribers. Official notice is taken that is old and well known in the art of Internet service to provide more than two graphical user interfaces for user to access the service. It would have been obvious to one of ordinary skill in the art at the time of the invention to require more than two graphical user interfaces before accessing the vendor site for the purpose of providing the user a first page, log-in page, to allow user login to the service provider's site and a second page, homepage, to allow the user to select a site he/she would like to access.

Regarding claims 11, 16, Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP; providing Internet service through graphical user interface provided by service provider (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded interface can provide user access the web, and direct access to the ISP's content partners (see page 76 col. 2 & 3). Netsurfer teach preventing the customer from accessing the Internet services from the service provider. Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer teaches using the SoftCast the ISP push content o a user computer and make changes to the computer and to push software updates, ...and can also fix problems including errors and software bugs... and update third party software (see 78 and 80). Netsurfer however does not teach providing Internet services to customer through a service provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches providing private-branded Internet connectivity, which enables e-businesses, affinity groups and web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes

Art Unit: 3622

custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches by using the system customers avoid the tremendous investment of building and maintaining a national network and the cost of staffing a customer care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's branded Internet service. One would be motivated to provide private-branded Internet service to e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the connectivity or service and customer care function enables the customers (vendors) to concentrate on building their business and avoid the tremendous investment of building and maintaining a national network, as taught by Ziplink (see page 1). Netsurfer teaches controlling the ability of the customer to add software or hardware. Netsurfer does not teach providing advertising, to the client based on customer's preferences. Official notice is taken to provide customized advertising to said client based on preferences received from the client is old and well known in the art of marketing. One would be motivated to provide advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Regarding claim 21, Netsurfer teaches a processor and a storage coupled to the processor (customer computer), the storage storing instructions that enable the processor to obtain Internet services. Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the ISP (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches when the Signup CD is loaded on user's computer the system posts the data to a server that sets up a user account, to provide Internet service (see page 78 col. 1&2). Netsurfer teaches using branded interface provides the

Art Unit: 3622

user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3).

Netsurfer teach loading the signup CD preventing the customer from accessing the Internet

services from the service provider. **Netsurfer teaches controlling the ability of the customer to**

add software or hardware. Netsurfer teaches using the SoftCast the ISP push content o a user

computer and make changes to the computer and to push software updates, ...and can also fix

problems including errors and software bugs... and update thirdparty software (see 78 and 80).

Netsurfer'however does not teach providing Internet services to customer through a service

provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches

providing private-branded Internet connectivity, which enables e-businesses, affinity groups and

web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes

custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and

news service, etc. Ziplink teaches by using the system customers avoid the tremendous

investment of building and maintaining a national network and the cost of staffing a customer

care operation center (see page 1). Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's

branded Internet service. One would be motivated to provide private-branded Internet service to

e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the

connectivity or service and customer care function enables the customers (vendors) to

concentrate on building their business and avoid the tremendous investment of building and

maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach

receiving, information about preferences and providing advertising to the client based on

preferences received form the client. Official notice is taken to provide advertising to said client

Art Unit: 3622

based on preferences received from the client is old and well known in the art of marketing. One would be motivated to provide customized advertising based on user preference in order to develop a one-to-one relationship with the user, by providing a targeted content.

Even if applicant's specification taught preventing (not allowing) of software adds. Ziplink teaches, under the private-branded Internet service, the customer provides full Internet service. Preventing users from downloading specific software, by controlling access, such as preventing user from accessing inappropriate web sites, and downloading software is inherent feature of Internet service.

Claims 12 and 22 are rejected as stated above in claim 2.

Claim 13 is rejected as stated above in claim 3.

Claims 14, 23 and 24 are rejected as stated above in claim 4.

Claim 15 is rejected as stated above in claim 5.

Claims 18, 26 are rejected as stated above in claim 8.

Claim 19 is rejected as stated above in claim 9.

Claim 20 is rejected as stated above in claim 10.

Regarding claim 25, Netsurfer teaches storing instruction that enable the system to control the initial graphical user interfaces from being changed (see page 78 col. 1&2).

Regarding claim 27, Netsurfer teaches user computer, which includes housing and display (see page 78 col. 1).

Regarding claim 36, Netsurfer as modified by Ziplink teaches providing customers (retail vendor) complete ISP options, however does not explicitly teach providing advertising based on another customer's on-line activities. Official Notice is taken that is old and well known in the

Art Unit: 3622

art at the time of applicant's invention was made to providing suggestion or recommendation on products based on another customer's preference or profile. Web site such as amazon.com provides recommendation to users based on what others purchased before. It would have been obvious to one of ordinary skill in the art to provide such advertising in order to recommend to users what to buy based on similar preference.

Regarding claims 37 and 38, Netsurfer as modified by Ziplink teaches providing customers (retail stores) with Virtual ISP program so customer can receive only those services that best meet their needs, such as dial-up, activation and authentication. Ziplink also teaches branded CD creation therefore, the client using the Virtual ISP will see the vendor site first, during sign-in and like any Internet service provider the vendor would be provide with a graphical user interface for customer to access other sites and to search. Therefore, since the vendor is the ISP, the first thing the customer see, is the vendor site and from the site the customer would be accessing the Internet or searching on the Internet.

Response to Arguments

Applicant's argument is in regard to claim 21 only. Applicant argues that claim 21 recites preventing the customer from adding software or hardware to the system and the prior art does not teach such feature. As stated above since applicant's specification does not teach preventing customer from adding software or hardware, in light of the specification Examiner interpret the word prevent as control. **Netsurfer teaches controlling the ability of the customer to add software or hardware.** Netsurfer teaches using the SoftCast the ISP push content o a user computer and make changes to the computer and to push software updates, ...and can also fix

Art Unit: 3622

problems including errors and software bugs... and update third-party software (see 78 and 80), which indicates that service provider controls what software can be downloaded (added).

Regarding claim 1, applicant in his argument states claim 1 as amended, the control includes restraining the customer's ability to add software or hardware. Merely providing pushed content or updates in no way suggests restraining the customer's ability to add. Further states to control the system, it may be advantageous to control the software and hardware on the user's system and thus an automated process is provided for preventing the addition of software or hardware on the user's system. There is nothing in the specification or the claim indicating that an automated process is provided for preventing the addition of software or hardware. The specification does not teach completely preventing users for adding any software or hardware.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


Art Unit: 3622

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yehdega Retta
Primary Examiner
Art Unit 3622

YR